

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Girard et al.
App. No : 10/539,527
Filed : July 10, 2006
For : NF-HEV COMPOSITIONS AND
METHODS OF USE
Examiner : Shin, Dana H
Art Unit : 1635

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION FROM REQUIREMENT FOR RESTRICTION
UNDER 37 C.F.R. §1.144

Dear Sir:

Pursuant to 37 C.F.R. § 1.144, Applicants hereby petition the Commissioner to review the Examiner's final decision to maintain the Restriction Requirement (withdrawal of claims 33-37 and 128) as set forth in the Office Action mailed April 29, 2008.

STATEMENT OF FACTS

On September 6, 2007 the Examiner issued an Office Action requiring restriction of claims 23-26, 28-37, 58-71 and 125-128 of the above-identified patent application. The Examiner alleged that claims should be divided into 16 different groups. In their response to this Restriction Requirement filed March 6, 2008, Applicants elected the claims of Group I with traverse. In particular, Applicants argued that all of the claims complied with the unity of invention requirement for U.S. national phase applications and that the Examiner erroneously limited independent claim 23 to methods of modulating the level or activity of NF-HEV by providing an antisense oligonucleotide, a limitation that appears only in dependent claim 31 (see

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Response to Restriction Requirement filed March 6, 2008 at pages 2 and 3). In the Office Action issued April 29, 2008, the Examiner found that all of the pending claims met the unity of invention requirement but still deemed the restriction proper under 37 C.F.R. § 1.475(b)-(d) (see Office Action issued April 29, 2008 at pages 2-3). Applicants now file this petition asking that the elected Group I claims 23-26, 28-32 and 127 be rejoined with the claims of Group IV (claims 33-37 and 128) because the claims of Group I and Group IV are all drawn to the same category of invention (that is, a method of ameliorating symptoms of a condition associated with inflammation).

ACTION REQUESTED

Applicants acknowledge that claims to any non-elected invention must be canceled prior to allowance. However, Applicants continue to traverse the Restriction Requirement, at least in part, for the reasons stated below and request rejoinder of withdrawn claims 33-37 and 128.

The requirements of 37 C.F.R. § 1.475(b) make it clear that an application containing claims to different categories of invention are considered to have unity if:

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

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Section 1.475(c) goes on to state that:

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

Finally, section 1.475(d) states that:

(d) If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).

A review of the claims of Group I (claims 23-26, 28-32 and 127) and Group IV (claims 33-37 and 128) reveals that all of these claims are drawn to method of ameliorating symptoms of a condition associated with inflammation. As such, the claims do not relate to a combination of categories of invention, but rather, a single category of invention. The Examiner has already acknowledged that unity of invention exists for all of the claims of the originally-presented claim set (see Office Action issued April 29, 2008 at page 2). As such, the claims of Group I and Group IV both possess unity of invention and relate to a single inventive category. Applicants can find no basis in the rules of practice for restricting the claims of Group I from the claims of Group IV. Accordingly, Applicants respectfully request that the claims of Group I and the claims of Group IV be re-joined for examination.

Conclusion

Applicants respectfully submit that the Examiner's grouping of inventions does not comply with the rules of restriction practice in U.S. national phase applications. Accordingly, the Applicants respectfully request that the Commissioner overrule the portion of the Examiner's restriction requirement which mandates the restriction of the claims of Group IV from the claims of Group I.

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The Commissioner is hereby authorized to charge any necessary fees, or make any credits, to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE MARTENS OLSON & BEAR, LLP

Date: October 28, 2008


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